

CARELLA, BYRNE, BAIN, GILFILLAN
CECCHI, STEWART & OLSTEIN
5 Becker Farm Road
Roseland, New Jersey 07068
(973) 994-1700
(973) 994-1744 (FAX)

OPERATOR:

RECEIVED
CENTRAL FAX CENTER

MAY 07 2008

TIME COMPLETED:

EXT. NO.: 524

DATE: 5/7/2008 OUR FILE NO.: 411000-146
US Patent application: s/n10569763 Walter Fix et al. Your file:

NAME FIRM: FAX NO.
Joannie A. Garcia USPTO AU 2823 571 273 8300

FROM: Total Pages Including Transmittal Sheet: 3
William Squire Reg. 25378

See attached MPEP 707.07(f) II "Examiner's Amendments" & MPEP 707.07(j) II "Allowable Except as to Form" wherein allowable subject matter should be recognized by the Examiner and suggested where applicable by Examiner's amendment, an examiner's amendment may be made after final rejection, MPEP 706.07(f) II and my call of 4/23/08 re proposed amended claim 1 to add that the substrate is an insulator. See applicants' Fig. 2 B6 and Fig. 3 C5. Figs. A2, B2, C2 which show laser formed depression in substrate (clear). Conductive material X (grey shading) and Y (black shading) is shown in depression Figs. B6 and C5. Substrate must be an insulator and thus can not be electrically conductive or else no conductive track can be formed in the depression. If the substrate is metal as in Yamamoto, then the substrate would short circuit the track. See Applicants' Spec. page 7, lines 20-24. The Action is in error. The so called Yamamoto depressions are a preformed roughened surface or matte finish and are not formed by a laser. The laser is used to form holes and not depressions. Holes and depressions are not the same. The so called depressions of Yamamoto are trough triangular shaped. Applicants refer to prior art with similar trough structures in DE 10061297.0, applicants' spec. page 1, lines 31-39. These rounded troughs do not work to form conductor tracks. The steep walls, sharp contours of claim 1 are not shown by Yamamoto whose troughs are smooth and rounded and not formed by a laser. Claim 1 is not shown or suggested by Yamamoto.

IF YOU HAVE ANY PROBLEMS WITH THIS TRANSMISSION, OR DO NOT RECEIVE THE NUMBER OF PAGES NOTED, PLEASE CONTACT THE FAX OPERATOR AT (973) 994-1700 (EXT. 523)

CONFIDENTIALITY NOTE: The documents accompanying this telecopy transmission contain information from the law firm of Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olstein, which is confidential and/or legally privileged. The information contained in this facsimile is intended only for the use of the individual named above and others who have been specifically authorized to receive it. If the one receiving it is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this communication is strictly prohibited. If you have received this telecopy in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at once. Thank you.

The original of this document will be sent by:



Messenger



This will be the only form of
delivery of this Document

344943v1

RECEIVED
CENTRAL FAX CENTER

MAY 07 2008

EXAMINATION OF APPLICATIONS

706.07(f)

II. EXAMINER'S AMENDMENTS

(F) Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action. Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.

(G) Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month, shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner.

(H) An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g., when an examiner's amendment is necessary after the shortened statutory period for reply has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process fee (as opposed to information product or service fees) to a credit card. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be given before the extended period expires. The authorization must be made of record in an examiner's amendment by indicating the name of the per-

son making the authorization, when the authorization was given, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged to the deposit account. Form Paragraph 13.02.02 should be used.

¶ 13.02.02 *Extension of Time and Examiner's Amendment Authorized by Telephone*

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Director to charge Deposit Account No. [4] the required fee of \$ [5] for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See MPEP § 706.07(f) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

III. PRACTICE AFTER FINAL

(I) Replies after final should be processed and considered promptly by all Office personnel.

(J) Replies after final should not be considered by the examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 37 CFR 1.136(a)). See also MPEP § 710.02(e). This requirement also applies to supplemental replies filed after the first reply.

(K) Interviews may be conducted after the expiration of the shortened statutory period for reply to a final Office action but within the 6-month statutory period for reply without the payment of an extension fee.

(L) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an *Ex parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters -- the correction of which had not yet been required by the examiner.

707.07(k)

MANUAL OF PATENT EXAMINING PROCEDURE

II. ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

III. EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

Form paragraphs 7.43, 7.43.01, and 7.43.02 may be used to indicate allowable subject matter.

7.43 Objection to Claims. Allowable Subject Matter

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7.43.01 Allowable Subject Matter. Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Independent Claim-Dependent Claim

Claim [1] would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Examiner Note:

This form paragraph is to be used when (1) the noted independent claim(s) or (2) the noted dependent claim(s), which depend from an allowable claim, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended to overcome the rejection.

7.43.02 Allowable Subject Matter. Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Dependent Claim

Claim [1] would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner Note:

This form paragraph is to be used only when the noted dependent claim(s), which depend from a claim that is rejected based on prior art, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended as indicated.

7.43.04 Suggestion of Allowable Drafted Claim(s). Pro Se

The following claim [1] drafted by the examiner and considered to distinguish patentably over the art of record in this application, [2] presented to applicant for consideration:

[3].

Examiner Note:

1. If the suggested claim is not considered to be embraced by the original oath or declaration, a supplemental oath or declaration should be required under 37 CFR 1.67.
2. In bracket 2, insert --is-- or --are--.
3. In bracket 3, insert complete text of suggested claim(s).

Form paragraph 7.97 may be used to indicate allowance of claims.

***>

7.97 Claims Allowed
Claim [1] allowed.

<

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

707.07(l) Comment on Examples

The results of the tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims